



2023 Roundtable Issue #1 – Patent Prosecution Proposals for Reforming “Prep and Pros” for the 21st Century

Proposal #1 – File Once, Examine Once, Issue Once, With a “Reissue” Safety Valve.

- Repeal 35 U.S.C. §120 to abolish continuation, continuation-in-part, and divisional applications.
- Continue “restriction practice,” but only by allowing patent examiners to require restriction of independent claims to a single, general inventive concept.
- Expand access to the patent reissue process by removing the “error” requirement and permitting broadening reissue applications to be filed within 6 years of the nonprovisional filing date.
- Impose additional filing, examination, issue, and maintenance fees based on excess claims (independent claims in excess of 3 and dependent claims in excess of 30), but with every claim presented in the application being subject to search and examination.

Proposal #2 – Streamline and Simplify Examinations for Patentability.

- Limit all “prior art” to subject matter available to the public (overrule *Helsinn*, but provide claimed inventions are unenforceable if (a) the claimed invention was “in public use or on sale” more than 6 years prior to its effective filing date and (b) the patent term extending more than 20 years from the first “in public use or on sale” date has not been disclaimed before the patent issue date.
- Eliminate invalidity/unenforceability for inventorship misjoinder/nonjoinder except that a patent would be unenforceable until inventorship has been corrected *if the correction would effect a change in patent ownership*.
- Abrogate obviousness-type double patenting as a ground of invalidity, but limit the patentably indistinct claims in separate patents to no more than 20 years of exclusivity from earliest patent issue date to latest patent expiration date and apply *res judicata* to bar the enforcement of patentable indistinct claims if *res judicata* would have applied had the indistinct claims issued in a single patent.

Proposal #3 – Enhance the “Duty of Disclosure” to Focus on the Most Pertinent Art.

- Require that every item of prior art in an “information disclosure statement” be accompanied by a concise description of its relevance.
- Require a per-item fee for consideration of “excessive” numbers of items of prior art in “information disclosure statements” in a patent application.
- With respect to any claim of a patent that is not invalid, bar any unenforceability defense based upon patent prosecution misconduct.

Why Should Patent Advocates Push for Profound Changes to “Prep and Pros” Now?

- The quality and integrity of U.S. patent examination has been under assault from critics of the U.S. patent system for decades. Any effort to elevate patent quality and patent system integrity must come from advocates for a strong patent system—not its critics—by coming together with proposals to eliminate any perceived abuses of the patenting process and to simplify and streamline it.
- The three proposals summarized above would do just that. Without any compromise to the ability of inventors to secure full protection for their inventions, these three proposals would allow patent examiners to devote essentially 100% of allotted examination time to §103/§112 issues, while focusing examination on the most pertinent prior art, and simultaneously addressing the knotty issue of “patent thickening.”